

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Beams, et. al.

Serial 09/934,924

No.:

Filed: August 22, 2001

For: Creating a Virtual Consultant

Atty. Docket 005222.00184
No.:

Group Art Unit: 2457

Examiner: Salad, Abdullahi
Elmi

Confirmation 9686
No.:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box Appeal Briefs - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This paper is responsive to the Final Office Action mailed on November 26, 2009. A Notice of Appeal is filed concurrently with this request for review. The Office is authorized to charge any associated fees to Deposit Account No. 19-0733.

Discussion and Argument

The Final Office Action mailed November 26, 2008 rejected independent claim 20 under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,310,349 (Daniels) in view of US Patent No. 6,427,063 (Cook). Claim 20 includes the following features (Emphasis added.):

20. **(Previously Amended)** A method for providing one or more virtual instructors, comprising the steps of:
- (a) connecting a server and one or more users and a first virtual instructor;
 - (b) selecting a destination within the server to interact with the one or more users;
 - (c) coupling the one or more users through the server based on the selected destination;
 - (d) establishing interaction parameters for the one or more users based on the selected destination; and
 - (e) **dynamically adding a second virtual instructor with the first virtual instructor and the one or more users.**

Regarding independent claim 20, Daniels and Cook, either individually or in combination, fail to even suggest the feature of “dynamically **adding a second virtual instructor** with the first virtual instructor and the one or more users.” (Emphasis added.) Similarly, Daniels and Cook fail to suggest the feature of “dynamically adding a second virtual instructor with the first virtual instructor and the one or more users” in independent claim 29 and the feature of “dynamically adding a second virtual instructor with the first virtual instructor and the one or more users” in independent claim 30.

Regarding independent claims 20, 29, and 30 the Office Action alleges (Page 2.

Emphasis added.):

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,231 USPQ 375 (Fed. Cir. 1986). In this case Daniel initially creates first virtual tutor as the examiner maintained all along. **However, Daniel is silent regarding creating second virtual tutor.**

The Office Action alleges (Page 4.):

Cook discloses an agent based instruction system including dynamically adding second virtual instructor (virtual tutor)(see col. 10, lines 25-67 and col. 62-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Cook such as dynamically adding second virtual instructor/tutor with the first virtual instructor and the one or more users into the system of Daniels in order to provide individualized guidance to the students.

Cook fails to remedy the deficiencies of Daniels. While Cook may discuss a virtual tutor of student 101 that is supported by agent software 108, Cook fails to discuss anything about a second virtual tutor and consequently fails to suggest the feature of "dynamically adding a second virtual instructor with the first virtual instructor and the one or more users." For example, agent software 108, in reference to fig. 1, interacts with student data object 109 (corresponding to student 101); however, Cook fails to even suggest interaction of agent 108 with a second agent. The Office Action further alleges (Pages 2-3):

... Here Cook provides the addition of additional virtual tutor into the system of Daniel to provide individualized guidance to the students. Furthermore, Cook also provides in addition to the software agent 108 another software module described as "Materials Engine" which is a software module that reference instructional materials data and tools data to present the instruction and the tools to the student. Materials engine 102 presents educational content such as instructional units, homework assignments, and testing to student 101.

However, Cook merely discusses agent software 108 that becomes a virtual tutor and that directly controls materials engine 102 through arrow 111 in the presentation of materials

data to student 101. (Column 11, line 49-column 12, line 45.) Consequently, Cook fails to suggest anything about a second virtual tutor.

Similarly, independent claim 29 includes the feature of “dynamically adding a second virtual instructor with the first virtual instructor and the one or more users.” Independent claim 30 includes the similar feature of “dynamically adding a second virtual instructor with the first virtual instructor and the one or more users.” Claims 21-28 ultimately depend from claim 20, and claims 31-38 ultimately depend from claim 30. In sum, the pending claims are each patentable over the cited prior art. The Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103(a) rejections.

Moreover, regarding claim 23, the Office Action alleges that (Page 5. Emphasis added.):

In considering claim 23, Daniels disclose the method for providing one or more virtual instructors as recited in claim 20, wherein the second virtual instructor becomes the principal (see col. 6, lines 36-63 and col. 14, lines 37-64).

However, Daniels fails to teach the feature of “wherein the second virtual instructor becomes the principal instructor.” As discussed above, Daniels fails to suggest anything about an instructor becoming the principal instructor. Claim 33 includes the similar feature of “wherein the second virtual instructor becomes the principal instructor.”

Also, regarding claim 27, the Office Action alleges that (Page 6. Emphasis added.):

In considering claim 27, Daniels disclose the method for providing one or more virtual instructors as recited in claim 20, wherein the second virtual instructor is selected by the first virtual instructor (see col. 6, lines 36-63 and col. 14, lines 37-64).

However, Daniels fails to teach the feature of “wherein the second virtual instructor is selected by the first virtual instructor.” As discussed above, Daniels fails to suggest anything about the first instructor selecting the second instructor. Claim 37 includes the similar feature of “wherein the second virtual instructor is selected by the first virtual instructor.

While Applicant believes the above points represent the clearest errors made by the Office Action, Applicant reserves the right to appeal on other bases and errors should the appeal of this case proceed after consideration of this paper. All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes that application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5419.

Respectfully submitted,

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